INDEX

	Page
Opinions below	1
Jurisdiction	1
Question presented	2
Statutes involved	2
Statement	2
Argument	4
Conclusion	9
Appendix	10

CITATIONS

Cases:

Abbott v. *Coe*, 109 F. 2d 449	6
Adamson v. *Gilliland*, 242 U. S. 350	5
Cuno Corp. v. *Automatic Devices Corp.*, 314 U. S. 84	9
Dow Co. v. *Halliburton Co.*, 324 U. S. 320	8
General Motors Corp. v. *Coe*, 120 F. 2d 736, certiorari denied, 314 U. S. 688, rehearing denied, 314 U. S. 715	5
General Talking Pictures Corp. v. *Western Electric Co.*, 304 U. S. 175	6
Hydraulic Press Corp. v. *Coe*, 134 F. 2d 49	5
I. T. S. Co. v. *Essex Co.*, 272 U. S. 429	6
Keller v. *Adams-Campbell Co.*, 264 U. S. 314	6
Keyes v. *Grant*, 118 U. S. 25	7
Layne & Bowler Corp. v. *Western Well Works, Inc.*, 261 U. S. 387	6
Magnaflux Corp. v. *Coe*, 139 F. 2d 531	5
McClain v. *Ortmayer*, 141 U. S. 419	8
Page v. *Arkansas Gas Corp.*, 286 U. S. 269	6
Smith v. *Hall*, 301 U. S. 216	8
Special Equipment Co. v. *Coe*, 324 U. S. 370	8, 9
Texas & N. O. R. Co. v. *Brotherhood Railway Clerks*, 281 U. S. 548	6
Textile Machine Works v. *Hirsch Co.*, 302 U. S. 490	8
Thomson Co. v. *Ford Motor Co.*, 265 U. S. 445	7
United States v. *Chemical Foundation*, 272 U. S. 1	6
United States v. *Commercial Credit Co.*, 286 U. S. 63	6
United States v. *Esnault-Pelterie*, 299 U. S. 201	7
Warren v. *Keep*, 155 U. S. 265	5
Washington Securities Co. v. *United States*, 234 U. S. 76	6
Williams Co. v. *Shoe Mach. Corp.*, 316 U. S. 364	6

709953—46

	Page
Statutes:	
Revised Statutes:	
Sec. 4886 (35 U. S. C. 31)	9, 10
Sec. 4915 (35 U. S. C. 63)	2, 10
Miscellaneous:	
Federal Rules of Civil Procedure:	
Rule 52 (a)	5

In the Supreme Court of the United States

OCTOBER TERM, 1946

No. 292

THE UNION METAL MANUFACTURING COMPANY, AND EDMUND W. RIEMENSCHNEIDER, AND MABEL ST. ELMO RASTETTER, EXECUTRIX OF HARRY O. RASTETTER, DECEASED, PETITIONERS

v.

CASPER W. OOMS, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The findings of fact and conclusions of law of the United States District Court for the District of Columbia (R. 13–15) were entered without an opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 159–160) is reported in 154 F. 2d 857.

JURISDICTION

The judgment of the Court of Appeals was entered on April 15, 1946 (R. 161). The petition for a writ of certiorari was filed on July 12,

1946. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether the courts below erred in upholding the rejection of petitioners' claims in the Patent Office on the ground that they do not disclose invention.

STATUTES INVOLVED

The statutes involved are set forth in the Appendix, *infra,* pp. 10–11.

STATEMENT

On November 8, 1944, petitioners brought this suit in the United States District Court for the District of Columbia, under R. S. 4915, 35 U. S. C. 63, *infra,* pp. 10–11, to obtain a judgment which would authorize respondent[1] to issue a patent containing claims 1 and 2[2] of application Serial No. 513,730, which was filed in the Patent Office on December 10, 1943, and which is a division of

---

[1] Respondents' predecessor as Commissioner of Patents was named as defendant in the complaint (R. 3). On August 27, 1945, however, respondent was substituted as defendant in lieu of his predecessor (R. 16).

[2] Claims 1 and 2 read as follows (R. 6–7, 14, 109, 123–124, 153, 159):

1. A longitudinal compression member having equal strength in all lateral directions comprising two elongated frusto-conical tubes in substantially straight axial alignment throughout their length with their large ends joined in abutment, and means at each end of said member for re-

application Serial No. 405,378, filed on August 4, 1941 (R. 2–13, 104). The claims relate, in general, to a longitudinal cylindrical tube, described as a "compression member", tapered toward each end (R. 6–7, 13–14, 104–112, 123–124, 153, 159). The tube thus described is useful as a member of an articulated radio antenna tower or as a ship boom (R. 13, 20–22, 25–30, 40–42, 68–72, 104–112, 116–118).

The Examiner rejected the claims as defining no invention over various prior cited patents (R. 119–120) and stated that lack of invention was so clear "that even outstanding commercial success * * * would not be enough to produce patentability" (R. 120).[3] On appeal (R. 121–

---

ceiving and transmitting compressive forces longitudinally through said member.

2. A longitudinal compression member having equal strength in all lateral directions comprising a central cylindrical tube and two elongated frusto-conical tubes in substantially straight axial alignment throughout their length and having their large ends joined in abutment with the ends of said cylindrical tube, and means at each end of said member for receiving and transmitting compressive forces longitudinally through said member.

[3] Petitioners state (Pet. 14) that the Examiner admitted "that some of his reasons for rejecting the pending claims were 'mere speculations' (R. 96)". It is to be noted (1) that the "admission" upon which petitioners rely is contained not in any decision with reference to the claims here in issue but rather in a Decision on Motions in an interference proceeding relating to the parent application, which Decision was rendered more than a month before the application here in issue was filed and (2) that the "admission" was not with reference to the examiner's finding that petitioners' claims had been anticipated by the prior art. (R. 92–96, 4–5.)

123), the decision of the Examiner was affirmed by the Board of Appeals in the Patent Office (R. 154). The Board noted that the Examiner was "not satisfied that the [commercial] success [of petitioners' device] is due to the inventive or unobvious nature of the construction" and found "that there is no doubt that the devices claimed are mere expedients when viewed in the light of the prior art" (R. 154).

After a trial (R. 17–40), the district court dismissed the complaint (R. 15–16), finding as facts that, in view of seven specified prior patents, petitioners' device disclosed no invention (R. 14–15), that "Neither of the claims in suit recites anything amounting to invention over the prior art", and that "Neither of the claims in suit is patentable" (R. 15). The court accordingly concluded that petitioners were "not entitled to receive a patent containing either of the claims in suit" (R. 15).

On appeal (R. 16–17), the court below affirmed the judgment of the district court (R. 160–161).

ARGUMENT

The court below held, *per curiam*, that "the novelty necessary to show inventive genius is lacking in these claims" and adopted the findings of fact of the district court to show that petitioners' "device had been anticipated" (R. 160). The court below held further that while petitioners had "proved the utility of their product as a cargo

boom, and its widespread acceptance by the shipping industry as a useful device", "a plain absence of invention is not overcome by evidence of usefulness and commercial success" (R. 160). The decision below is clearly correct in each of its aspects.

1. The device here involved is a simple one. It consists essentially of two elongated frusto-conical members, secured together at their bases or, alternatively, of a similar arrangement in which a cylindrical member is placed between the bases of the cones. From the decision of the Examiner in the Patent Office (R. 119–120), from the decision of the Patent Office Board of Appeals (R. 152–154), from the findings of fact of the district court (R. 13–15), and from the decision below (R. 159–160) which adopted those findings (R. 160), it is obvious that prior patents disclose structures which are similar to that of petitioners' device as defined in their claims, and that their device presents no inventive difference. The findings of the district court to this effect are, of course, not to be set aside unless clearly wrong (Rule 52 (a), F. R. C. P.; *Adamson* v. *Gilliland,* 242 U. S. 350; *Warren* v. *Keep,* 155 U. S. 265; *Magnaflux Corp.* v. *Coe,* 139 F. 2d 531 (App. D. C.); *General Motors Corp.* v. *Coe,* 120 F. 2d 736 (App. D. C.), certiorari denied, 314 U. S. 688, rehearing denied, 314 U. S. 715; *Hydraulic Press Corp.* v. *Coe,* 134 F. 2d 49 (App. D. C.)), particularly since they were concurred in by the court

below. *Williams Co.* v. *Shoe Mach. Corp.*, 316 U. S. 364, 367; *Page* v. *Arkansas Gas Corp.*, 286 U. S. 269, 271; *United States* v. *Commercial Credit Co.*, 286 U. S. 63, 67; *Texas & N. O. R. Co.* v. *Brotherhood of Railway Clerks*, 281 U. S. 548, 558; *I. T. S. Co.* v. *Essex Co.*, 272 U. S. 429, 433; *United States* v. *Chemical Foundation*, 272 U. S. 1, 14; *Washington Securities Co.* v. *United States*, 234 U. S. 76, 78. The conclusion that those findings are not erroneous is fortified by the fact that they are in agreement with the determination of the Examiner and the Board of Appeals in the Patent Office. See *Abbott* v. *Coe*, 109 F. 2d 449, 451–452 (App. D. C.). This Court will not ordinarily review issues of fact in cases of this character. *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, 319; cf. *Layne & Bowler Corp.* v. *Western Well Works, Inc.*, 261 U. S. 387; *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U. S. 175.[4]

[4] There is obviously no merit to petitioners' contention (Pet. 7–8, 20–25) that the findings of the district court (R. 13–15) were inadequate. In its findings, that court stated briefly what petitioners' application disclosed (R. 13), what the claims recited (R. 14), and what the patents which anticipated petitioners' device disclosed (R. 14). The district court then made findings that certain differences between petitioners' device and the structures shown by prior patents would not involve invention, and expressly found that neither of petitioners' claims recited "anything amounting to invention over the prior art" (R. 15). From these findings, the conclusion (R. 15) that petitioners were "not entitled to receive a patent containing either of the claims" necessarily followed.

Petitioners contend, however (Pet. 9–10, 26–27), that the question whether their device represents invention is one of law rather than of fact. It is well settled, of course, that whether an improvement in the arts constitutes invention is ordinarily a question of fact. *Thomson Co.* v. *Ford Motor Co.*, 265 U. S. 445; *United States* v. *Esnault-Pelterie*, 299 U. S. 201; *Keyes* v. *Grant*, 118 U. S. 25. But petitioners rely on decisions (Pet. 9, 26–27) which indicate that the question of invention may be one of law if a mere comparison of structures is involved and extrinsic evidence is not needed to explain them. However, it is clear that something more than a mere comparison of structures is here involved and, indeed, petitioners have relied heavily on extrinsic evidence (Pet. 7, 20–21). Moreover, even regarding the question of invention as one of law would not materially strengthen petitioners' position, for they have failed to show that the two courts below or the Examiner or Board of Appeals in the Patent Office erred in comparing the structure of petitioners' device with that of devices covered by the patents which the courts below found to have anticipated petitioners' (R. 14–15, 160).

2. While the court below found that petitioners had "proved the utility of their product as a cargo boom, and its widespread acceptance by the shipping industry as a useful device" (R. 160), it held (R. 160) that "commercial success does not supply the lacking invention." "Only when there

is doubt as to invention or novelty is proof of practical utility and general commercial acceptance permitted to turn the decision in favor of patentability" (R. 160). *McClain* v. *Ortmayer,* 141 U. S. 419; *Smith* v. *Hall,* 301 U. S. 216; *Textile Machine Works* v. *Hirsch Co.,* 302 U. S. 490; *Dow Co.* v. *Halliburton Co.,* 324 U. S. 320, 330. If it is clear that there is no invention, then no amount of commercial success can support a holding of patentability.

In this connection, petitioners contend that, in making its findings of fact, the district court erred in ignoring the evidence as to the commercial acceptability of their device (Pet. 5, 7, 20–21). However, there was no reason why findings as to commercial success should have been made. There was, in the first place, no dispute on this point. Moreover, since lack of invention was clear and conclusive, commercial success was immaterial and there was no occasion for making a finding with respect to it. In any event, petitioners were not prejudiced by any such lack in the findings since it is clear that, on appeal, the court below considered the commercial success of petitioners' device and accepted it as "proved" (R. 160).

3. Since the claims in issue are subcombination claims, petitioners assert that they are patentable under the decision of this Court in *Special Equipment Co.* v. *Coe,* 324 U. S. 370 (Pet. 5–6, 15–17). It is true that that case held that subcombination claims may be allowable. However, the present claims have not been rejected because they are

subcombination claims, but because they define no invention.[5] Subcombination claims are not *ipso facto* allowable. Like all others, they stand or fall on their own merits. The fact that claims define something which is "new and useful" is not enough; "invention" or "discovery" must also be present. R. S. 4886, 35 U. S. C. 31, *infra*, p. 10; *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84. Accordingly, the fact that petitioners' claims are subcombination claims is immaterial.

CONCLUSION

The decision of the court below is correct, no question of general importance is presented, and the controversy turns on questions of fact. The petition for a writ of certiorari should therefore be denied.

Respectfully submitted.

J. HOWARD MCGRATH,
Solicitor General.

JOHN F. SONNETT,
Assistant Attorney General.

ABRAHAM J. HARRIS,
Attorney.

W. W. COCHRAN,
Solicitor.

E. L. REYNOLDS,
Law Examiner.
United States Patent Office.

AUGUST 1946.

[5] The Patent Office's rejection of the claims in the *Special Equipment* case was not based on prior art. 324 U. S. at 373.

APPENDIX

Section 4886 of the Revised Statutes (35 U. S. C. 31):

> Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

Section 4915 of the Revised Statutes (35 U. S. C. 63):

> Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in

which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

U. S. GOVERNMENT PRINTING OFFICE: 1946